



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:
040894-7374-US

"I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed
Name _____

Application Number:
10/564,761

Filed:
January 17, 2006

First Named Inventor:
T. OGAWA et al.

Art Unit:
3721

Examiner:
L. Low

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages are provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

attorney or agent of record.

Registration number 51,410

Signature

Arthur M. Antonelli

Typed or printed name

202-739-5717

Telephone number

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

September 9, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.



PATENT
Attorney Docket No. 040894-7374

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: T. OGAWA et al.) Confirmation No.: 1486
)
Application No.: 10/564,761) Art Unit: 3721
)
Filed: January 17, 2006) Examiner: L. Low
)
For: CYLINDRICAL CONTACT ARM)
HAVING TAPERED GUIDE SECTION)
IN A POWER-DRIVEN)
NAILING MACHINE (As Amended))

U.S. Patent and Trademark Office
Customer Window, Mail Stop AF
Alexandria, VA 22314

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action of June 11, 2008 ("the pending Office Action"), Applicants respectfully request a pre-appeal brief review of the pending rejections. A Notice of Appeal is filed concurrently herewith.

As explained in the Remarks section of the Amendment filed on February 28, 2008, and further explained below, Applicants respectfully assert that claims 1 and 3-20 are not anticipated by JP-A-2002-337066 and are not obvious over JP-A-2002-337066 (or U.S. Patent No. 6,578,750 to Kubo et al.) in view of U.S. Patent No. 1,241,996 to Kristiansen.

Claim 1

Claim 1 recites a power-driven nailing machine comprising, in part,

"a nose body having a lower end with a nail discharge port; and a contact nose...having an upper end and a leading end, including a cylindrical portion formed at its upper portion such that the cylindrical portion defines a circular cylindrical bore extending from an interior of the contact nose to the upper end, the nose body being housed in the circular cylindrical bore such that the contact

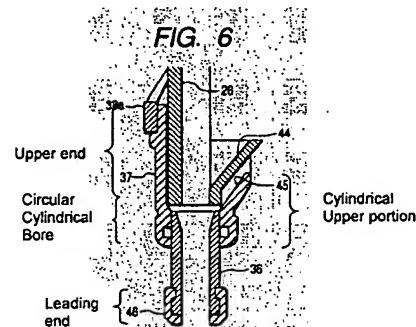
nose is held slidably along the nail discharge port of the nose body."

In the pending Office Action, the examiner rejected claim 1 based on paragraph 3 of the Office Action mailed on October 29, 2007 (which in turn referred to paragraph 9 of the Office Action mailed March 26, 2007) and marked up FIG. 6 from page 3 of the pending Office Action (reproduced below). Applicants respectfully disagree.

As an initial matter, the Examiner states that JP-A-2002-337066 is not U.S. Patent No. 6,578,750 ("Kubo et al."), but then refers to earlier rejections based on FIG. 6 of Kubo et al. to show an alleged anticipation of claims 1 and 3-16. These rejections are flawed and confusing because they are based on information that the Office Action states is not from the allegedly anticipatory reference (JP-A-2002-337066), and thus should be withdrawn. Moreover, the obviousness rejection of claim 1 cites a series of earlier rejections that address deleted claim limitations, but do not address each element of the pending claim. Thus, the pending rejections of claim 1 as anticipated or obvious are flawed and should be withdrawn.

When looking at the Examiner's marked-up FIG. 6, applicants submit that the alleged "upper end" as construed by the Examiner is an unduly broad interpretation of the term "upper end." Construing the top half of the alleged contact nose as the "upper end" is simply not credible nor justified in light of the specification, and thus is not reasonable. *See e.g.*, FIG. 2, Specification, p. 8:22 to 9:3. *See also*, MPEP 2111.

Moreover, marked up FIG 6 does not disclose "a contact nose having an upper end..., including a cylindrical portion...such that the cylindrical portion defines a circular cylindrical bore extending from an interior of the contact nose to the upper end." **Referring to marked up FIG. 6 (above), portion 45 and portion 37 do not define a circular cylindrical bore. The tapered bore at the proximal end of portion 36, likewise, does not define a circular**



Marked up FIG. 6 from page 3 of the pending Office Action

cylindrical bore. Thus, FIG. 6 does not show “a circular cylindrical bore extending from an interior of the contact nose to the upper end” of the contact nose, as recited by claim 1. See also, Kubo et al. at FIG. 5.

Moreover, the rejection does not articulate (nor does marked up FIG. 6 show) a nose body having a nail discharge port that is “housed in the circular cylindrical bore such that the contact nose is held slidably along the nail discharge port of the nose body,” as further recited by claim 1.

For these reasons, JP-A-2002-337066 (or marked up FIG 6) does not disclose a “contact nose” as recited by claim 1, and thus the rejection of claim 1 as anticipated should be withdrawn. Because Kubo et al. and Kristiansen alone or in combination do not remedy these deficiencies, the rejections of claim 1 based on obviousness should also be withdrawn.

Claim 8

Claim 8 recites in part:

“a nail supply mechanism disposed between the driving cylinder and the fourth end of the nose body such that the nail supply mechanism supplies the at least one-sized nail to the nose body, the nail supply mechanism being configured and dimensioned to accommodate only nails having a length less than or equal to the distance measured along the longitudinal axis from the leading end of the contact nose to a farthest extent of the radial enclosure.”

JP-A-2002-337066, Kubo et al. and U.S. Patent No. 1,241,996 to Kristiansen (“Kristiansen”) do not disclose the “nail supply mechanism” recited by claim 8. *See e.g.*, Amendment dated February 28, 2008. Nor has the Examiner articulated how JP-A-2002-337066, Kubo et al. and U.S. Patent No. 1,241,996 to Kristiansen allegedly disclose a “nail supply mechanism as recited by claim 8. Thus, claim 8 is not anticipated by these references, and the rejection should be withdrawn.

The pending rejection of claim 8 based on 35 USC 103(a) is also flawed because it cites a series of earlier rejections that address deleted claim limitations, but do not address each element of pending claim 8. *See*, page 4 of the pending Office Action. Moreover, the statement on pages 4 and 5 of the pending Office Action that “Kubo’s (and Kristiansen’s) nail supply mechanism can be ‘configured and dimensioned’...as required by claim 8” admits this limitation is missing

and is merely conclusory. *See* MPEP 2143.01 III and IV. Accordingly, the pending rejections of claim 8 are in error and should be withdrawn.

Claim 17

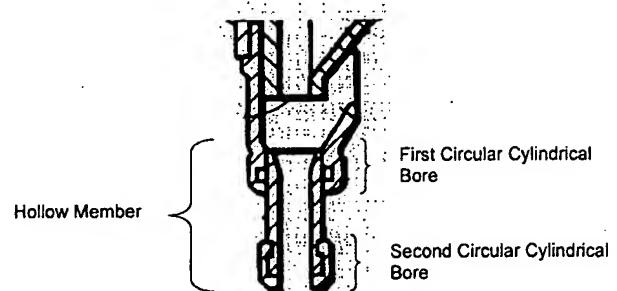
Claim 17 recites:

“The power driven nailing machine of claim 8, wherein the proximal end of the hollow member comprises a first circular cylindrical bore defined by the inner surface and the fourth end of the nose body is circumferentially received within the first circular cylindrical bore.”

In the pending Office Action, the examiner rejected claim 17 as anticipated based on paragraph 3 of the Office Action mailed on October 29, 2007 (which in turn referred to paragraph 9 of the Office Action mailed March 26, 2007) and a second figure marked up from page 3 of the pending Office Action (reproduced below). Applicants respectfully disagree.

The March 26, 2007 Office Action states that “contact nose 36 includes a hollow member (45) that has proximal and distal ends (FIG 1), inner and outer surfaces (Fig. 1), and is slidable relative to the nose body (26).” Office Action dated 3/26/2007, p. 4 lines 9-10. In the pending Office Action, the rejection further relies on the second marked up figure reproduced above.

Neither the original alleged hollow member (45) nor the newly alleged hollow member in the second marked up figure (reproduced above) show a circular cylindrical bore at the proximal end of the hollow member. Instead, the proximal end of the alleged hollow member includes spaces having non-circular and non-uniform cross-sections transverse to the longitudinal axis of the alleged hollow member. *See also*, Office Action dated 10/29/2007, page 3, lines 21-22 (stating that upper portion 37 is “mostly cylindrical”). **Moreover, the alleged nose body is not “circumferentially received” within**



Second marked up figure from page 3 of the pending Office Action

the alleged first circular cylindrical bore. Accordingly, the Examiner's pending rejection based on 35 U.S.C. 102(b) fails to disclose a "hollow member" as recited by claim 17.

The pending rejection of claims 17-20 based on 35 U.S.C. 103(a) are flawed for the same reasons as the obviousness rejections of claims 1 and 8 (above). *See*, page 4 of the pending Office Action. Furthermore, JP-A-2002-337066 or Kubo et al. has not been shown to disclose or suggest a "nail supply mechanism" as recited by claim 8. While Kristiansen shows a nail guide 19 in the form of a tube, the nail guide 19 can accept and deliver nails longer than the outlet to the flared cup portion 16. Thus, Kristiansen fails to remedy the deficiency of JP-A-2002-337066 or Kubo et al., and the rejection of claim 17 under 35 U.S.C. 103(c) should be withdrawn. *See e.g.*, MPEP 2143.03 (All words in a claim must be considered in judging the patentability of that claim against the prior art).

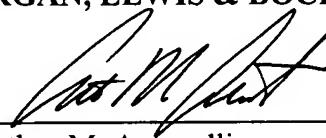
Dependent claims 3-7 are patentable for the same reason claim 1 is patentable.

Dependent claims 9-20 are patentable for the same reason claim 8 is patentable. Claims 18-20 are further patentable for the same reason claim 17 is patentable.

In view of the foregoing, reconsideration and timely allowance of the pending claims are respectfully requested. If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: 

Arthur M. Antonelli
Reg. No. 51,410

Dated: September 9, 2008

Customer No.: 009626
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Telephone: 202.739.3000
Facsimile: 202.739.3001